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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,320	07/31/2000	ERIC R. SCHORMAN	PF02024NA	4698

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MOTOROLA INC  
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LIBERTYVILLE, IL 60048-5343

EXAMINER
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HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

12

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/629,320

Applicant(s)

SCHORMAN ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10-01-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***EXAMINER'S RESPONSE***

1. In response to applicant's amendment filed 10-01-03, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Objections***

2. Claims 12-13 are objected to because of the following informalities: Claims 12 and 13 depend from canceled claim 11. For purposes of prior art rejections made below, Claims 12-13 will be considered to depend from claim 10. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 5, 8-9, 10, 14, 17-19, 20-21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl (WO 98/17032) in combination with DeSimone (US 6212548).

Regarding independent claims 1, 10 and 20, Borgstahl discloses an wireless peer-to-peer network 22 that is considered

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to be an ad-hoc network of peers 20 that include a database 42, processor 40 and user output device 46 in figure 2. The peers (or members) broadcast to others a need/capability message 64 including an ID 66 corresponding to an announcement in page 10 line 30 - page 11 line 7. These messages exchange information to build a database in the peers. A peer may receive data from a service receiving peer and announce the collected data audibly or visibly on a portable or stationary device in page 15 lines 9-22. Borgstahl differs from the claims by not including the user output device outputting concurrently information including an identity of a person associated with each of the plurality of members.

DeSimone discloses an analogous art peer to peer communication system with user output device displaying a list of names identifying participants or members available for chat and/or list of names in chat to allow establishing and maintaining multiple simultaneous message sessions. See col. 1 lines 1-48, col. 5 lines 40-54 and col. 13 line 61 - col. 14 line 40. Figs. 3 and 7 show display of lists and fig. 2B shows a peer to peer network. Peer to peer allows improved real time performance and more immediate control in col. 15 lines 28-53.

It would have been obvious to have included in Borgstahl user output display listing a plurality of names identifying

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messaging participants and/or people available for participation (connected to the network) as disclosed in DeSimone because this allows establishing and maintaining multiple simultaneous message sessions. The combination is suggested by Borgstahl disclosing a peer to peer network advantageously providing a vast and diverse assortment of services and DeSimone disclosing a messaging service in a peer to peer system where peer to peer network operation permits improved real time performance and more immediate control.

Regarding claim 5, 14 and 21, Borgstahl includes Proximity in page 5 line 2.

Regarding claim 8, Borgstahl includes RF and IR in page 5 lines 2-5.

Regarding claim 9, Borgstahl includes visual or audible output in page 15 and DeSimone includes a visual display.

Regarding claims 17-19 the exchanging of needs and capabilities and/or the collecting of data in Borgstahl builds a database.

Regarding claims 26-27 Borgstahl includes a processor 40 associated with output device 46 that is a display in page 15 lines 9-22.

5. Claims 1, 3, 5-6, 11-12, 14, 16, 21, 23-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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Borgstahl (WO 98/17032) in combination with DeSimone (US 6212548) as applied above and further in view of Chern (US 6381465).

Chern discloses an analogous art communication system with user output device displaying visually or announcing by voice an index or list of available services for user selection in col. 8 lines 18-67. The services may be listed, ranked or sorted according to user preference such as proximity in col. 11 lines 5-26 and col. 12 lines 29-43.

Regarding claims 3, 12 and 24, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have ordered the list in the combination applied above as claimed because the services of Chern may be sorted by user preferences. This suggests that the list may be displayed in the order received without sorting, or the preference could be time corresponding to chronological order received.

Regarding claims 5, 14, 21 and 28-30 the display of Chern includes a list that is sorted or ranked by proximity.

Regarding claims 6, 16, and 23, the examiner previously argued that signal strength is a well known manner to determine the proximity of Chern. Since applicant did not argue this issue, it now considered to be admitted prior art. See MPEP 2144.03.

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6. Claims 4, 13 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl (WO 98/17032) in combination with DeSimone (US 6212548) and Chern (US 6381465 as applied above and further in view of Will (US 5479408).

Will discloses an analogous art two way pager and method including queue with order dependent on urgency. See cols. 18 and 23. It would have been obvious to have included the list or queue order dependent on urgency of Will in the combination applied above to assure that priority data is transmitted in a timely manner.

7. Claims 3, 7, 12, 15, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl (WO 98/17032) in combination with DeSimone (US 6212548) and Chern (US 6381465 as applied above and further in view of Perkins (US 5412654).

Perkins discloses an analogous art ad-hoc network and method including in col. 6 information ranking preferences based on time or number of hops. It would have been obvious to have included the list or display in the combination applied above according to the order of time or number of hops disclose in Perkins as preference for making connection decisions.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3-10 and 12-30 filed 10-01-03 have been considered but are moot in view

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of the new ground(s) of rejection.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dickson (US 4173016) discloses an interpersonal introduction signaling system and Allen (US 5119226) discloses an infrared network entry permission apparatus.


**CONTACT INFORMATION**

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is (703) 305-4700.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH  
12/12/03

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635